

REMARKS

The applicant acknowledges receipt of the initialed copy of the Form PTO-1449 which was filed on May 29, 2007.

On the initialed copy of the Form PTO-1449 filed on 30 January 2006, the examiner omitted initials next to one of the references. A mark-up copy of the Form PTO-1449 is attached for the examiner's reference. The examiner is again requested to completely initial and return a copy of the Form PTO-1449 which was filed on 30 January 2006.

Claims 1-3, 6-10, 13-18 and 20-54 are pending. Claims 29-53 have been withdrawn. Claim 4 has been canceled, so that there are 25 pending non-withdrawn claims, of which three are independent. The applicant respectfully requests reconsideration and allowance of this application in view of the above amendments and the following remarks.

The drawings were objected to, on the basis that in FIG. 10-13, 16-18B, 20, 22 and 23, the views are not labeled properly; words are not horizontal and left-to-right; lines, numbers, and letters are not uniformly thick and well defined; and numbers and references are not plain and legible. It is unclear why the views are considered to not be labeled properly, since the figure numbers are accurate and properly placed. In addition, it is unclear why the words are considered to not be horizontal and left-to-right, since the words on each sheet are horizontal and left-to-right. Furthermore, since all of the comments apparently do not apply to each of the figures, the objection is not well understood. Submitted herewith are replacement sheets for FIG. 10-13, 16-18B, 20, 22 and 23, in which the figure numbers have been replaced. Also, in FIG. 16 and FIG. 17, the margins are corrected. In FIG. 18B, the hand-lettered words "No" and "Yes" have been replaced. Also, in FIG. 22 (as well as FIG. 21, not objected to), the figures are rotated slightly to be more on the horizontal and the reference numbers have been replaced. Further, in

FIG. 23, the hand-lettered words and reference numbers have been replaced. The applicant respectfully requests that the examiner indicate that the drawings are accepted. If something in FIG. 10-13, 16-18B, 20, 22 and 23 is still considered to be unclear, the examiner is respectfully requested to be specific so that it can be corrected.

Claims 1-4, 6-10, 13-18, 20-28 and 54 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 6,877,137, Rivette et al. (“Rivette `137”) in view of U.S. Patent No. 6,389,434, Rivette et al. (“Rivette `434”). The rejection is respectfully traversed for reasons including the following, which are provided by way of example.

The applicant’s prior discussions of Rivette `137, Rivette `434, and their deficiencies are expressly incorporated herein by reference.

The examiner argues with regard to claim 1 that Rivette `137 teaches a mark-up resource. However, claim 1 does not recite a mark-up resource. The argument with regard to a mark-up resource in claim 1 appears to be superfluous and will be disregarded.

Independent claims 1, 18 and 25 are amended to recite, in combination, “to combine the annotation data and the document data to form a unitary single logical document, the single logical document displaying the annotation embedded seamlessly in the document data...”. Support for the amendment is located in the application as filed, for example, page 32, lines 10-12. Accordingly, the document (such as a patent) can be marked up with annotations, so that the document (e.g., a patent) appears to have additional physical information seamlessly embedded therein and the marked-up document presents a unitary appearance. However, the annotations for different users are maintained separately so that unrelated users are protected from disclosing their marked-up documents to each other. (Page 32, lines 1-13).

Fig. 7A of Rivette '434 (cited by the examiner as being particularly relevant) is reproduced below, with the elements 604 and 704 being circled. The examiner contends that elements 602 and 702 are the document data. The examiner contends that elements 604 and 704 are the annotations embedded seamlessly in the document data. The examiner contends the element 402 is "a unitary single logical document, the single logical document displaying the annotation embedded seamlessly in the document data" where "the annotation is image data or text".

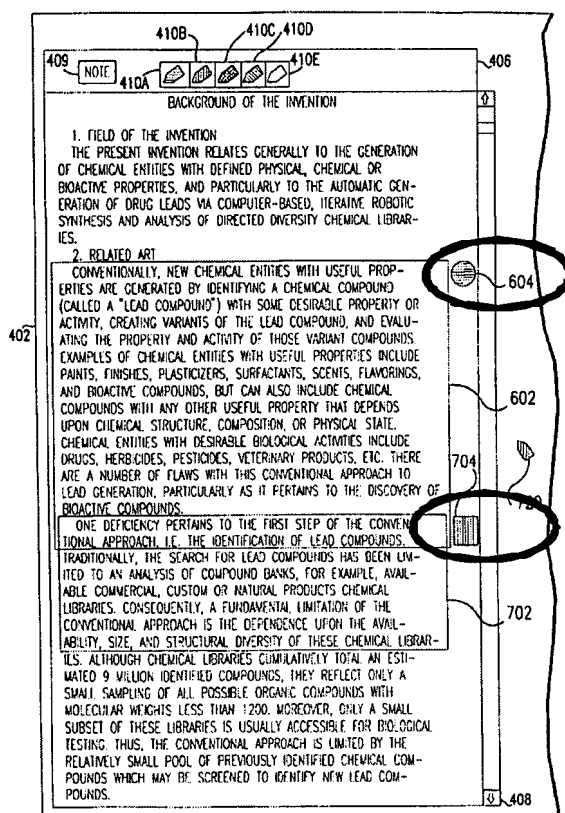


FIG. 7A

As one can easily see, Rivette '434's annotations (604, 704) are not embedded in the document data (402, 702). To the contrary, Rivette '434's annotations (604, 704) are completely

outside the document data (402, 702). Therefore, Rivette `434 fails to teach or suggest “displaying the annotation embedded seamlessly in the document data.”

Essentially, the examiner argues that the “annotation” (recited in “the single logical document displaying the annotation embedded in the document data” wherein “the annotation is image data or text”) is taught by an HTML link displayed far apart from the text. To support the rejection, the Office Action, pages 9-10 contains three separate figures from Rivette `434 (such as FIG. 7A reproduced above), illustrating how multiple documents can be traversed via linking buttons displayed off to the side of each document. The examiner argues that these multiple documents show “the annotation data embedded in the document data” and constitute a single document. However, claim 1 recites “the single logical document displaying the annotation embedded seamlessly in the document data.” Moreover, claim 1 further recites that “the annotation is image data or text.”

The examiner contends that multiple documents linked by HTML links meet the language of claim 1. Such is completely contrary to the claim language and, furthermore, is an unreasonably broad interpretation of the claims. Significantly, the examiner is deliberately reading out claim limitations which recite “the annotation is image data or text” and “the single logical document displaying the annotation embedded in the document data” (previous claim 1). The office action cites Rivette `434, shown for example in FIG. 7A, in which the document displays a link to the annotation (linking button 604); “linking button 604 associated with the selected text is used to navigate to and display the sub-note (i.e., Sub-note A1) that is linked to the selected text.” (Col. 15, lines 8-10.) Significantly, the text or image data of Sub-Note A1 is never displayed embedded in the document data. More to the point, Rivette `434’s document which is displayed with a link to an annotation fails to teach or suggest “a unitary single logical document, the single logical document displaying the annotation embedded seamlessly in the

document data” where “the annotation is image data or text”. According to the examiner, several documents which one must traverse via HTML links which are presented to the user only individually, in series after the HTML links have been traversed, is the same as a unitary single document with the annotation (as image data or text) embedded seamlessly therein.

The examiner continues to contend that embedding an HTML link outside of the document data is sufficient to meet the recited limitation of “the annotation” embedded “in” the document data. To the contrary, a document with a link to a note does not teach or suggest a “unitary single logical document” with “the annotation embedded seamlessly in the document data.” (See independent claims 1, 18 and 25.) This is particularly true where “the annotation is image data or text.” There are at least three points where the examiner ignores words in the independent claims:

(1) A linking button in a display is not “image data or text.”

(2) A series of linked documents is not a “unitary single logical document.” where the single logical document displays the annotation embedded seamlessly in the document data. Multiple documents does not meet the limitation of “unitary single” document.

(3) Something which is displayed outside of the document data is clearly not displayed “in the document data,” no matter how the term “in the document data” is interpreted. Specifically, even the most tortured interpretation of “in the document data” cannot encompass “outside of the document data.” To make this abundantly clear, the claims now recite “seamlessly in the document data.”

The examiner continues to contend that displaying a screen where notes are displayed in separate windows from the document (e.g., FIG. 6A, 6B), and where the note link buttons are displayed to the side of the relevant text, teaches “a single logical document having the

annotation data embedded in the document data.” Rivette `434’s note link buttons are not “embedded seamlessly in” the document data, even if “embedded seamlessly in” is given its broadest reasonable interpretation. To the contrary, the link buttons are displayed away from the document data.

Furthermore, neither Rivette `434 nor Rivette `137 teaches or suggests that each annotation that is embedded in the document data “can be different from every other annotation.” Even if the examiner interprets Rivette `434’s note link buttons as the recited annotation data, the user is limited to predetermined note link buttons which accordingly cannot be different from every other note link button.

To compound the error of eviscerating language from the claim, the examiner is reading the claims in a vacuum and interpreting the claim language in a manner which is completely unreasonable. *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) (“Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their ‘broadest reasonable interpretation’.” 710 F.2d at 802, 218 USPQ at 292 (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)) (emphasis in original). Rivette `434’s several linked documents with linking buttons displayed to the side which are used to traverse the linked documents are completely different from “at least one merge component configured: ...to combine the annotation data and the document data to form a unitary single logical document, the single logical document displaying the annotation embedded seamlessly in the document data” where “the annotation is image data or text.” (See claims 1, 18, 25.) It is completely unreasonable for the examiner to omit the words “single”, “unitary,” or “embedded seamlessly” from the claims. Consequently, Rivette `434 fails to teach or suggest the recited merge component.

In *In re Buszard*, (06-1489, Fed. Cir. Sep. 27, 2007), the Federal Circuit Court of Appeals recently explained that “during examination, the patent application claims may be given their broadest interpretation consistent with the specification, in order to facilitate sharpening and clarifying the claims at the application state.” In *In re Buszard*, the court overruled the rejection and explained that the examiner used an unreasonably broad interpretation of a “flexible foam mixture” when he construed that wording to include a rigid foam mixture crushed into small particles which can ultimately produce a flexible foam mixture. *In re Buszard* is not much different than the present application. Whereas in *In re Buszard*, the examiner contends that unrelated small particles together produce a flexible foam mixture (because the crushed particles are flexible and together constitute a “foam,” as broadly interpreted), here the examiner contends that unrelated documents ultimately together produce a unitary document.

A “single document “ or a “unitary document” cannot be construed to encompass “multiple documents”. As with *In re Buszard*, the examiner’s interpretation of “single document” or “unitary document” as encompassing multiple documents is unreasonably broad.

An annotation “embedded seamlessly in the document data” cannot be construed to be a linking button provided non-seamlessly far away from the document data. More particularly, the word “in” does not mean “far away from.” Therefore, the examiner’s interpretation of “displaying the annotation embedded seamlessly in the document data” as encompassing linking buttons displayed completely separate from the document data is unreasonably broad.

Independent claim 18, additionally recites “at least one split component configured: to extract the annotation data and the document data from the single logical document, to update the at least one annotation in the first data storage from the extracted annotation data, and to update the at least one document in the second data storage from the extracted document data.” The

office action, page 12, argues that Rivette `137's note/object linking information database teaches the data which has been split, and the configuration "to extract the annotation data and the document data from the single logical document" is met by Rivette `137's ability to attach a note to a document. Clearly, the examiner is arguing that the wording "extract ... from the single logical document" encompasses "attached ... to a document." No one would consider the phrase "extract ... from" to encompass "attach ... to." The examiner's interpretation is manifestly unreasonable. For this additional reason, the rejection of independent claim 18 cannot be sustained.

Accordingly, the examiner has failed to make a prima facie case of obviousness with respect to independent claims 1, 18 and 25.

For at least these reasons, the combination of features recited in independent claims 1, 18 and 25, when interpreted as a whole, is submitted to patentably distinguish over the cited references. In addition, Rivette `137 and Rivette `434 fail to show other recited elements as well, as discussed above.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from allowable independent claims 1, 18 and 25, but also because of additional features they recite in combination.

For example, claim 3 recites that "the at least one merge component is further configured to display the single logical document as a representation of the at least one document." The examiner relies on Rivette `434's display as being the single logical document, such that there is no difference in Rivette `434's merge component between combining the annotation data and document data, and displaying the single logical document. However, under the doctrine of claim differentiation, these are separate elements. Since the examiner cites a single element of

Rivette `434 as meeting two different recited elements, the rejection of claim 3 cannot be sustained.

Claim 7 recites “at least one split component, responsive to said single logical document, configured: to extract the annotation data and the document data from the single logical document ...” The office action, page 16, argues that Rivette `137’s note/object linking information database teaches the data which has been split, and the configuration “to extract the annotation data and the document data from the single logical document” is met by Rivette `137’s ability to attach a note to a document. Clearly, the examiner is arguing that the designation “extract ... from the single logical document” encompasses “attached ... to a document.” This is a manifestly unreasonable interpretation. The rejection of claim 7 cannot be sustained.

Claim 8 recites that “the at least one annotation indicates an evaluation of at least one legal property relative to the at least one document.” On page 18 of the office action, the examiner argues that Rivette `137 teaches this. However, in no way can the linking button of Rivette `434 be expanded to include any evaluation of at least one legal property relative to the at least one document. These simply cannot be combined, and the office action provides no reason why such a combination would be made with the necessary modifications.

The applicant respectfully submits that, as described above, the cited art does not show or suggest the combination of features recited in the claims. The applicant does not concede that the cited references show any of the elements recited in the claims. However, the applicant has provided specific examples of elements in the claims that are clearly not present in the cited art.

It appears that the examiner has withdrawn the Advisory Action’s attempt to incorporate by reference the Microsoft OLE Programmers Reference, Volumes I and II, 1993.

However, in the present office action the examiner applies the Microsoft Word for Windows Users Guide, 1994, which he states is “incorporated herein by reference in their entirety.” If the examiner applies a reference, as done here, the examiner must make the reference of record. The examiner cannot make a reference of record by attempting to incorporate by reference. Rather, “Copies of cited foreign patent documents and non-patent literature references (except as noted below) are automatically furnished without charge to applicant together with the Office action in which they are cited.” MPEP 707.05(a). Further, the reference must be listed by the examiner on a Notice of References Cited document. The examiner has not provided any valid reason why the cited reference has not been provided to the applicant. Accordingly, any rejection relying on the Microsoft Word for Windows Users Guide must be withdrawn, or the portion of the reference which is relied on must be supplied.

The applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples applicant has described herein in connection with distinguishing over the references as limiting to those specific features in isolation. Rather, for the sake of simplicity, the applicant has provided examples of why the claims described above are distinguishable over the cited references.

In view of the foregoing, the applicant submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Cynthia K. Nicholson', written over a horizontal line.

Cynthia K. Nicholson

Reg. No. 36,880

Posz Law Group, PLC
12040 South Lakes Drive, Suite 101
Reston, VA 20191
Phone 703-707-9110
Fax 703-707-9112
Customer No. 23400